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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,214	10/06/2003	Hideki Nakamura	117454	2386
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EXAMINER				
SHEPARD, JUSTIN E				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/678,214

**Applicant(s)**

NAKAMURA ET AL.

**Examiner**

Justin E. Shepard

**Art Unit**

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see Amendment After Final, filed 5/1/09, with respect to the rejection(s) of claim(s) 1 and 13 under Ellis have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Stumphauzer.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 13 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The television receiving method including steps of receiving a signal and determining whether the signal meets a criteria is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 7-9, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Stumphauzer.

Referring to claim 1, Stumphauzer discloses a digital broadcast reception apparatus for receiving a digital broadcast (figure 1, part 1040; paragraph 15) including a program (paragraph 21) and program guide information for providing a guide to the program content (paragraph 22), the digital broadcast reception apparatus comprising:

a broadcast reception unit for receiving a digital broadcast on air (figure 1, part 1040);

a condition determination unit (paragraphs 19 and 20) for determining whether or not the program matches a search condition (paragraph 28) on the basis of the program guide information received by the broadcast reception unit (paragraph 49); and

a program search unit for making a program search by controlling the broadcast reception unit (figure 2, part 2140)

to continue to receive the digital broadcast containing the program, which is determined matching the search condition by the condition determination unit (figure 7, part 7040; NO condition), and

to stop receiving the digital broadcast containing the program, which is not determined matching the search condition by the condition determination unit and to receive another digital broadcast (figure 7, part 7060);

wherein in the program search, a plurality of programs that match the search condition and that are contained in the received digital broadcast are presented to a user for a predetermined time in sequence (figure 7).

Claim 13 is rejected on the same grounds as claim 1.

Referring to claim 2, Stumphauzer discloses a digital broadcast reception apparatus according to claim 1 further comprising: a condition input unit for accepting an entry operation of a condition; and a condition setting unit for setting the condition input in the condition input unit as the search condition (paragraph 31).

Referring to claim 5, Stumphauzer discloses a digital broadcast reception apparatus according to claim 2, wherein the condition input unit accepts an operation of specifying a program genre as the condition (paragraph 28).

Referring to claim 7, Stumphauzer discloses a digital broadcast reception apparatus according to claim 1, wherein: service types of the digital broadcast include

video, audio, data, and temporary broadcast; and the program search unit makes the program search for each program service (paragraphs 27 and 28).

Referring to claim 8, Stumphauzer discloses a digital broadcast reception apparatus according to claim 2, wherein: the condition input unit is input into a keyword concerning at least one of a program name, cast, and program detail information; and the condition setting unit sets the search condition to receive a program containing the keyword input into the condition input unit (paragraph 28).

Referring to claim 9, Stumphauzer discloses a digital broadcast reception apparatus according to claim 1, further comprising: a request input unit allowing to input a program trial reception request while the program search unit is executing the program search (paragraph 44); and a control unit for controlling the program search unit to stop the program search and controlling the broadcast reception unit to execute program trial reception when the program trial reception request is input into the request input unit (paragraph 45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stumphauzer in view of Ellis (US Patent Number 7,065,709).

Referring to claim 3, Stumphauzer does not disclose a digital broadcast reception apparatus according to claim 2, wherein: the condition input unit accepts an entry operation of selecting the condition from a previously prepared list including a plurality of conditions; and the condition setting unit sets the condition, which is selected by the condition input unit accepting the entry operation, as the search condition.

In an analogous art, Ellis teaches a digital broadcast reception apparatus according to claim 2, wherein: the condition input unit accepts an entry operation of selecting the condition from a previously prepared list including a plurality of conditions; and the condition setting unit sets the condition, which is selected by the condition input unit accepting the entry operation, as the search condition (figure 9a).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the prepared search lists taught by Ellis to the system disclosed by Stumphauzer. The motivation would have been to enable a user to search quickly by using predefined search terms.

Referring to claim 4, Stumphauzer does not disclose a digital broadcast reception apparatus according to claim 2, wherein: the condition input section accepts an entry operation of a plurality of conditions and an operation of specifying a logical operation for the conditions; and if the user specifies the logical operation for the conditions input through the condition input unit, the condition setting unit sets the input conditions

together with the specified logical operation as the search condition.

In an analogous art, Ellis teaches a digital broadcast reception apparatus according to claim 2, wherein: the condition input section accepts an entry operation of a plurality of conditions and an operation of specifying a logical operation for the conditions; and if the user specifies the logical operation for the conditions input through the condition input unit, the condition setting unit sets the input conditions together with the specified logical operation as the search condition (figure 9a).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the prepared search lists taught by Ellis to the system disclosed by Stumphauzer. The motivation would have been to enable a user to search quickly by using predefined search terms.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stumphauzer in view of Legall.

Referring to claim 6, Stumphauzer discloses a digital broadcast reception apparatus according to claim 2, wherein: service types of the digital broadcast include video, audio, data, and temporary broadcast (paragraphs 27 and 28).

Stumphauzer does not disclose a digital broadcast reception apparatus according to claim 2, wherein: the condition input unit accepts an operation of specifying at least one of the service types as the condition.

In an analogous art, Legall teaches a digital broadcast reception apparatus according to claim 2, wherein: the condition input unit accepts an operation of specifying at least one of the service types as the condition (figure 3B, part 341).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the source search selection taught by Legall to the apparatus disclosed by Stumphauzer. The motivation would have been to enable the user to better specify the selection criteria so as to enable a better content match.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stumphauzer in view of Goraya.

Referring to claim 10, Stumphauzer does not disclose a digital broadcast reception apparatus according to 9, wherein: the request input unit allows to input a program search restart request for stopping the program trial reception and restarting the program search; and when the program search restart request is input into the request input unit, the control unit controls the program search unit to restart the program search at the program search stop state.

In an analogous art, Goraya teaches a digital broadcast reception apparatus according to 9, wherein: the request input unit allows to input a program search restart request for stopping the program trial reception and restarting the program search; and when the program search restart request is input into the request input unit, the control unit controls the program search unit to restart the program search at the program search stop state (paragraph 87).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the search pausing and restarting taught by Goraya to the apparatus disclosed by Stumphauzer. The motivation would have been to enable the user to stop the search if something interesting is found on the default channel (Stumphauzer: paragraph 44) that the user would want to add to the search criteria (paragraph 31).

Referring to claim 11, Stumphauzer discloses a digital broadcast reception apparatus according to claim 10, further comprising: a condition retention unit for retaining the search conditions set by the condition setting unit (figure 5, part 5030).

Referring to claim 12, Stumphauzer discloses a digital broadcast reception apparatus according to claim 11, wherein the condition determination unit determines whether or not the program matches the search condition retained in the condition retention unit (figure 7).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS

/Joseph G Ustaris/  
Primary Examiner, Art Unit 2424